

## Remarks

The Office Action rejected all claims as allegedly being either anticipated by U.S. Patent 5,801,747 ("Bedard") or obvious over Bedard in view of either U.S. Patent 5,819,156 ("Belmont") or U.S. Patent 6,177,931 ("Alexander").

The Applicant herein cancels claims 4, 8, 16, 20, 27, 40, 54, 57, 60, 75, and 77-78 and amends claims 1, 5, 9, 13, 17, 21, 26, 31, 36, 52, 55, 56, and 76. Claims 62-64 were withdrawn by the Applicant's last submission. Independent claims 1, 13, and 26 are amended by incorporating the limitations of canceled claims 4, 16, and 27, respectively. Claims 5, 17, 55, and 56 are amended to change their dependencies, as their base claims have now been canceled. Claims 9, 21, and 31 are rewritten in independent form. Claim 36 is amended to include limitations based on canceled claim 40, and claim 52 is amended to include limitations based on canceled claims 54 and 57. Finally, method claim 76 is amended to clarify one step.

The Applicants believe that all claims are allowable and that the rejections should be withdrawn for at least the following reasons.

### Claims 1, 13, 26, and Their Dependents

Independent 1, 13, and 26 were rejected under 35 U.S.C. § 102(b) as allegedly being "clearly anticipated" by Bedard. By way of example, claim 1 is amended herein to read as follows:

1. A method for generating a list of channel favorites in an interactive television system, comprising:
  - receiving a first notification, the first notification indicating a first channel activity;
  - receiving a second notification, the second notification indicating a second channel activity;
  - calculating a time difference between the first and the second notifications; and
  - updating a channel favorites table based on the calculated time difference, wherein the favorites tables includes a favorites display preference.

Claim 1 recites the limitations of canceled claim 4 and thus refers to “a favorites display preference.” Claims 13 and 26 have been amended to recite a similar feature originally recited in canceled claims 16 and 27.

The Office action’s rejection of claim 4 reads as follows:

Referring to claim 4, Bedard discloses that the favorites table includes a favorites display preferences (see Figure 2 for the favorites table having a total of all viewing units recorded and all viewing units for each category that are representative of favorite display preferences that will be displayed in an electronic program guide). (Office action, pages 3-4.)

The same ground of rejection was also applied to claims 16 and 27. Although the rejection is not perfectly clear, it appears that either the Office action is interpreting “favorites display preference” to mean a display of preferred favorites or the Office action is contending that the particular table shown in Bedard’s Figure 2 is somebody’s preferred display form. Neither makes sense.

As a matter of claim interpretation, the phrase “favorites display preference” means a preference in the manner, arrangement, ordering, style, etc. in which the favorites are displayed. Various forms of this feature are described in the specification at, for example, page 6, lines 13-17; page 7, lines 8-12; page 16, line 23 – page 17, line 6; page 19, line 21 – page 20, line 7; and page 24, line 15 – page 25, line 7. Bedard, on the other hand, does not disclose that the data from his “viewer profile array 200” can be displayed in any preferred way. To wit, Bedard certainly does not disclose that his viewer profile array 200 itself includes a “favorites display preference.” Indeed, Bedard’s Figure 2 illustrates the viewer profile array 200. Thus, Figure 2 represents an internal data structure, not an on-screen display. Thus, to the extent that the Office action contends that Figure 2 represents a “favorite display preference,” that is not so; it represents, if anything, a data storage format preference. Notably absent from that Figure 2 data structure is any field that would indicate a preference relating to the display of the favorites data therein.

As none of the other references of record cure this deficiency in Bedard, the rejection of claims 1-3, 5-7, 10-12, 13-15, 17-19, 21-24, 26, 28-30, and 32-34 should be withdrawn for the foregoing reasons. The Applicant believes that the preceding claims are in condition for allowance.

Claims 9, 21, and 31

Claims 9, 21, and 31 were rejected under 35 U.S.C. § 102(b) as allegedly being obvious over Bedard in view of Belmont. By way of example, claim 9 is amended herein to read as follows:

9. A method for generating a list of channel favorites in an interactive television system, comprising:  
receiving a first notification, the first notification indicating a first channel activity;  
receiving a second notification, the second notification indicating a second channel activity;  
calculating a time difference between the first and the second notifications; and  
updating a channel favorites table based on the calculated time difference, wherein the updating is performed if the calculated time difference is larger than about ten seconds.

Claim 9 thus states that the “updating is performed if the calculated time difference is larger than about ten seconds.”

The Applicant submits that the claims with this feature are patentable over the prior art of record. The Office action maintained that claims 9, 21, and 31 are allegedly obvious over Bedard in view of Belmont. Those rejections are flawed for three reasons. First, the teachings of Bedard and Belmont are fundamentally incompatible. Whereas Bedard teaches ignoring viewings having durations less than his “viewing unit,” Belmont teaches affirmatively tracking “channel surfing”:

Tracking/reporting device 18 can also track the amount of time a user spent per channel “channel surfing,” such as by tracking a channel where a user spends 3-10 seconds per channel. (Belmont, col. 3, lines 61-64) (emphasis added)

Because tracking small-duration events is fundamentally opposed to ignoring small-duration events, one skilled in the art would take from Belmont no teaching to modify Bedard in any way. For that reason, the rejections should be withdrawn. Assuming, however, that one were to ignore that fundamental difference and simply take from Belmont his passing mention that a channel surfing event might last 3-10 seconds per channel, then the rejections should still be withdrawn for the next two reasons.

The second reason for withdrawing these rejections is that there is no motivation to modify Bedard's viewing unit to be as small as "about ten seconds." The Office action's statement of motivation goes as follows:

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, [sic] to modify the favorite channel tracking system, as taught by Bedard, using the "channel surfing" tracking system, as taught by Belmont, for the purpose of providing a tracking device to track, record and report various uses of a PC/TV convergence device, such as a set top box (see Column 1, Lines 65-67 of Belmont).

This alleged motivation, even assuming it did make sense\*, is not a reason to replace a fifteen-minute or one-minute viewing unit with a 3-10 second viewing unit. In fact, nothing in Belmont suggests changing the length of Bedard's viewing unit.

This brings us to the third reason the rejections should be withdrawn, namely, that modifying Bedard in this manner would be contrary to Bedard's express teachings and would compromise the usefulness and advantages of Bedard's system. On this point, the Office action mistakenly characterized Bedard as "silent for teaching that the predefined time can be set for about ten seconds" (Office action, page 7, ¶ 4) (emphasis added). Far from being silent on this point,

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\* On its face, this motivation is absurd for the reasons already discussed: The "favorite channel tracking system, as taught by Bedard" fundamentally ignores – rather than tracks – "channel surfing," as "the 'channel surfing' tracking system, as taught by Belmont," does.

however, Bedard actually contemplates considerably longer times, such as fifteen minutes:

While monitoring viewing behavior, the viewer profile will consider short durations of viewing any one channel to be insignificant. Such short viewing durations could result, for example, from a viewer surfing through numerous channels without stopping on any one channel for a significant period of viewing time. By ignoring insignificant viewing periods, the viewer profile is able to focus upon a viewer's true interests and prevent numerous short unrepresentative viewing durations from skewing the data concerning the viewer's true preferences. The viewer profile will thus only consider significant those viewing periods longer than one viewing unit. One skilled in the art will understand that the time duration represented by one viewing unit can be varied (e.g., 1 minute, 5 minutes, 10 minutes, etc.), but illustratively, and for the purpose of describing the present invention, one viewing unit will be defined as fifteen minutes in duration. Therefore, only viewing durations longer than one viewing unit, or fifteen minutes, will be considered in determining the viewer's preferred categories of television programming and preferred channels. (Bedard, col. 3, line 63 – col. 4, line 14).

Indeed, Bedard discloses no "viewing unit" less than one minute. This is so because Bedard's viewing unit is more than just a threshold for determining whether to ignore a viewing event; it is the increment by which viewing time is counted. (See, e.g., Bedard's Figure 2.) Bedard achieves computational and processing simplification by counting viewing events in rather large-size units, which can be treated as integers, typically rather small integers. Because this virtue of Bedard's system would be lost by adopting a viewing unit size on the order of 3-10 seconds – values mentioned in passing by Belmont – one of ordinary skill in the art would not be motivated to make that modification.

For all of the foregoing reasons, the Applicant requests that the § 102(b) rejection of claims 9, 21, and 31 be withdrawn.

### Claims 25, 35, and 61

Claims 25, 35, and 61 are written in means-plus-function form and must be interpreted according to the statutory mandate of 35 U.S.C. § 112, ¶ 6. The Office action has not done so. Specifically, the Office action did not identify the corresponding structures in the specification or show that the references disclose the same or equivalent structures. In particular, the Office action has done nothing more than allege that the cited reference (Bedard) performs the identical functions recited in these claims. More is required of the Office, as stated in MPEP § 2182:

[I]f a prior art reference teaches identity of function to that specified in a claim, then under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function. (emphasis added.)

Unless and until the Office performs these steps to satisfy its initial burden, it is pointless for the Applicant to respond to the rejections. Unless and until the Office satisfies its burdens, the claims must be deemed to be patentable, until proven otherwise.

### Claims 35, 43-51, and 65-74

Claims 35, 43-51, and 65-74 (of which claims 35, 43, and 65 are independent) stand rejected as allegedly being obvious over Bedard in view of Alexander. These claims refer to certain processing, acts, means, or elements at a “server.” The Office action correctly recognizes that in Bedard’s system all processing, acts, means, and elements are at a viewer’s equipment, such as a set top box. The Office action therefore turns to Alexander, specifically to his teaching of certain processing performed remotely at a television system’s head end. The Office action alleges that one skilled in the art, in light of Alexander, would know to modify Bedard to perform some of Bedard’s processing at a head

end. The sole motivation advanced by the Office action to support this assertion is “for the purpose of providing improved features to the EPG display and navigation (see Column 2, Line 8 of Alexander).” (Office action, ¶ 5, page 8.)

While it is true that the cited passage of Alexander does mention “[i]mproved features to the EPG display and navigation,” those are broad objects of Alexander’s overall invention, which is an involved system described and illustrated over 35 dense pages. Significantly, the Office action has pointed to nothing in Alexander that attributes – or in any way links – those objects with the fact that the claimed limitations are placed or performed at a head end or other “server,” as opposed to a set top box. That is because Alexander provides no such linking, as – not surprisingly – that would not make sense. There is simply no reason why having certain elements – let alone, the claimed limitations – place or performed at a head end, rather than a set top box, would provide improved EPG display or navigation. Because there is no proper motivation to modify Bedard in light of Alexander, the § 103 rejections based on Alexander must be dropped.

Claims 36-39, 41-42, 52-53, and 55-56 and 58-59

The above-listed claims (of which claims 36 and 52 are independent) stand rejected as allegedly being “clearly anticipated” by Bedard. Claim 36 has been amended to recite a limitation similar to that found in original claim 40 (now canceled), and claim 52 has been amended similarly with respect to canceled claims 54 and 57. By way of example, claim 36 now reads:

**36.** An apparatus for creating favorite channels in an interactive television system, comprising:  
a processor;  
a generation engine executable by the processor and capable to generate a list including at least one favorite channel based upon a selection of a channel; and  
a display engine executable by the processor and capable to enable the display of the list, wherein the list includes a plurality of channels listed based upon the numbers of times the respective channels has been watched.

Thus, claim 36 refers to “a plurality of channels listed based upon the numbers of times the respective channels has been watched.” Bedard does not disclose or suggest this feature. Instead, Bedard only keeps track of the number of viewing units for any particular channel. As steps 300-308 in Bedard’s Figure 3 shows, if a viewer watches the same channel for multiple viewing units uninterrupted, that is recorded as several viewing units, not one. Bedard has no provision to separately keep track of “the numbers of times the respective channels has been watched.” This is clear from Bedard’s description of step 308:

If, however, the timer indicates that one or more viewing units has elapsed, then the viewer profile determines at step 306 whether the viewed channel is already in the viewer profile array 200. If the viewed channel is already an entry 202 in array 200, viewing unit counters 204 and 206 of entry 202 are incremented (step 308) by one or more viewing units, and the viewer profile then restarts (step 300) the timer for the new channel. (Bedard, col. 5, lines 41-48) (emphases added).

In light of the foregoing, the Applicant believes that the rejection of claims 36-39, 41-42, 52-53, and 55-56 and 58-59 should be withdrawn and that those claims are in condition for allowance.

#### Claim 76

Claim 76 reads as follows:

**76.** A method for generating a list of channel favorites in an interactive television system, comprising:  
    receiving, from an electronic program guide, a first electronic program guide notification, the first notification indicating viewing of a first channel;  
    receiving, from the electronic program guide, a second electronic program guide notification, the second notification indicating viewing of a second channel;  
    calculating a time difference between the first and the second notifications;



prompting a viewer, after receiving the second electronic program guide notification, for authorization to update a channel favorites list; and  
if authorization is received, updating the channel favorites list based on the calculated time difference.

The Office action asserts that claim 76 is allegedly “clearly anticipated” by Bedard, reasoning that “the prompting limitation is being specifically interpreted as the user using the EPG (the prompt) for updating the favorite channel list, every time a program is selected from the EPG.” While the Applicant appreciates the Examiner’s explicit explanation of his claim interpretation, the Applicant respectfully submits that that interpretation is not tenable given the amendments made to the claim. Essentially, the Examiner is interpreting an “electronic program guide notification” and the recited “prompt[] . . . for authorization” as the same thing. However, as amended, the claim states the “prompting” step takes place “after receiving the second electronic program guide notification.” Clearly, Bedard does not disclose or suggest such a prompt, as the Office action implicitly acknowledged. For this reason, the Applicant request that the rejection of claim 76 be withdrawn and the claim be allowed.

### Conclusion

The Applicant believes that all claims are in condition for allowance and respectfully requests issuance of a Notice of Allowance. The Examiner is invited to call the undersigned attorney if any issues remain.

Respectfully submitted,

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